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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,444	01/06/2005	Tetsuo Uchibori	SAEG103.003APC	2790
20995 7590 01/23/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER GARRETT, DAWN L				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
01/23/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

# Office Action Summary

## Application No.

10/520,444

## Applicant(s)

UCHIBORI ET AL.

## Examiner

Dawn Garrett

## Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-12 and 19 is/are rejected.
- 7) ☒ Claim(s) 13-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This Office action is responsive to the amendment filed October 15, 2008. Claims 1 and 10 were amended. Claims 6-9 are cancelled. Claim 19 has been added. Claims 1-5 and 10-19 are pending and under consideration.
2. The objection to claim 1 set forth in the last Office action (mailed May 15, 2008) is withdrawn due to the amendment.
3. The rejection of claims 1-5, 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Shores (US 5,304,419) is withdrawn due to the amendment requiring the presence of an amine compound.
4. The rejection of claims 12-16 under 35 U.S.C. 103(a) as being unpatentable over Shores (US 5,304,419) in view of Nikaido (US 4,013,566) is withdrawn due to the amendment.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4, 5, 10-12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malhotra et al. (US 5,908,723). Malhotra et al. teaches recording sheets comprising an ink spreading polymeric agent that may comprise polyacrylic acid (per the instant "polyacrylic resins") (see col. 1, lines 57-67 and col. 2, line 1-2), p-phenylenediamine compounds (see col. 2, lines 21-24), and fillers such as clay, calcium carbonate and colloidal silica that read upon the

instant “hygroscopic agent” (see col. 2, line 26). Per claim 2, magnesium oxide is further taught as a filler (see col. 25, lines 1-15). With regard to claim 5, Malhotra et al. teaches the filler (“hygroscopic agent”) is contained in a layer in an amount of 1 part by weight to about 50 parts by weight (see col. 25, lines 3-4). With regard to claim 12, the preamble of the claim is directed only to a formed body in a location, but does not expressly require a device in combination with the formed body. All of the limitations of the formed body of claim 1 are met by Malhotra et al. With regard to claim 19, Malhotra et al. discloses magnesium oxide (see col. 25, lines 1-15) as a filler, which may also read upon a thermal conductor. With regard to claim 10, the thermal conductivity property is considered to be inherently met by the disclosure of magnesium oxide, since it is a thermal conductor specifically set forth by applicant, absent evidence otherwise. Recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims. *General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773. Applicant bears responsibility for proving that reference composition does not possess the characteristics recited in the claims. *In re Fitzgerald*, 205 USPQ 597, *In re Best*, 195 USPQ 430. Similarly, it is not expressly clear if the filler (“hygroscopic agent”) taught by Malhotra et al. comprises the surface area property recited in claim 4. Since Malhotra et al. teaches materials which are the same as those specified by applicant, such as alkaline earth oxide compound magnesium oxide, it would appear that the same property would be inherent to the magnesium oxide absent evidence otherwise. Furthermore with regard to claim 11, since water is commonly known to have a density of 1.0 g/cm<sup>3</sup>, one would expect the Malhotra et al. solid material to have at least a density

of at least  $1.0 \text{ g/cm}^3$  given the components of the composition material, absent evidence otherwise.

Malhotra et al. is silent with respect to *exemplifying* a recording sheet comprising the specifically selected filler, resin, and phenylenediamine; however, it would have been obvious to one of ordinary skill in the art at the time of the invention to have formed a sheet having the above discussed specific components in combination, because one would expect the combination of the materials to result in a desirable recording sheets, since each of the components is expressly taught as suitable for the recording sheet.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malhotra et al. (US 5,908,723) in view of Takahashi (US 6,344,303). Malhotra et al. teaches filler material for a recording sheet such as calcium carbonate and magnesium oxide, but does not expressly teach CaO, SrO or BaO as filler material. Takahashi teaches in the analogous art of recording medium that inorganic filler material may include calcium carbonate and magnesium oxide as well as CaO (see col. 8, lines 55-61). It would have been obvious to one of ordinary skill in the art to have selected CaO filler material for the filler material of the Malhotra et al. recording sheet, because one would expect CaO to perform suitably as a filler similar to either calcium carbonate or magnesium oxide.

#### ***Response to Arguments***

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

*Allowable Subject Matter*

9. Claims 13-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach or to render obvious an EL device comprising a moisture removing sheet or method for reducing moisture or dark spots in an EL device using a moisture removing sheet comprising the very specific components as required by these claims.

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is (571) 272-1523. The examiner can normally be reached Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dawn Garrett/  
Primary Examiner, Art Unit 1794